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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,960	10/09/2003	Joachim von Heimburg	CM1968DQ	7785

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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EXAMINER

BETTON, TIMOTHY E

ART UNIT	PAPER NUMBER
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1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/681,960	Applicant(s) VON HEIMBURG ET AL.	
	Examiner Timothy E. Betton	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to more than one species of the generic invention.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Specifically, applicant is required to elect one species of a tissue paper product comprising a tissue paper substrate and a protease inhibiting composition, the protease inhibiting composition being transferable from the tissue paper substrate onto the skin and being present in an amount sufficient to inhibit protease activity upon the skin, wherein the protease inhibiting composition comprises at least one ester compound, wherein the ester compound is of the formula wherein R10 and R11 are independently an alkyl, alkenyl, arylalkyl, hydroxyalkyl, alkoxy group of from 2 to 24 carbon atoms, hydroxy group, or hydrogen; wherein R3, R7, R8, and R9 are independently an alkyl, alkenyl, arylalkyl, hydroxyalkyl, alkoxy group of from 1 to 24 carbon atoms, hydroxy group, or hydrogen; A and B are independently a CrC6 linear or branched alkylene, alkenylene, alkoxylenes, hydroxyalkylene groups; the value of x is from 0 to 15; the value of y is 0 or 1, wherein when x=2 and y=2, at least one R2 is an alkyl, alkenyl, hydroxyalkyl group with from 1 to 24 carbon atoms or hydrogen.

Species Election of a tissue paper substrate and a Protease Inhibitor

Sole claim 1 requires a species election of one specific group for R10 and R11 each, respectively. Applicant must elect one group for R1 and one group for R11, consisting as disclosed of: an 1) alkyl, 2) alkenyl, 3) arylalkyl, 4) hydroxyalkyl, 5) alkoxy group. Applicant must also elect a specific number of 1) carbon atoms, 2) hydroxy, or 3) hydrogen in accordance with the specific moiety requirement outlined above.

Same instant claim 1 requires a species election for R3, R7, R8, and R9, wherein they are independently an 1) alkyl, 2) alkenyl, 3) arylalkyl, 4) hydroxyalkyl, 5) alkoxy group of from 1 to 24 carbon atoms, hydroxy group, or hydrogen. Applicant must elect one group for each R3, R7, R8, and R9 as above. Applicant must also elect a specific number of 1) carbon atoms, 2) hydroxy, or 3) hydrogen in accordance with the specific moiety requirement outlined above.

Further in instant claim 1, Applicant must elect one exact species for A and B each independently, i.e., a 1) C1-C6 linear, or a 2) C1-C6 branched. Upon the species election for either instant 1) or 2), applicant must elect one exact species further consisting of an 1) alkylene, 2) alkenylene, 3) alkoxyethylene, 4) hydroxyalkylene groups for the 1) linear or 2) branched moiety.

Applicant must elect one specific numeric value for x, consisting of disclosed range, for example x=7. Additionally Applicant must elect either 0 or 1 for the specific numeric value of y, for example, y=1. If Applicant elects when x=2 and y=2, the R2 branches (if more than one) must contain one specific group each consisting of an 1) alkyl, 2) alkenyl, or 3) hydroxyalkyl group. Applicant must also elect a specific numeric

value consisting of disclosed range 1 to 24, (e.g. C or H=15). Further, of the specific number elected, Applicant must elect whether moiety will comprise a 1) carbon atoms or 2) hydrogen.

Sole claim 1 is therefore generic to the above electable species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Applicant is advised that a reply to this requirement must include a proper identification of species that is elected consistent with this requirement, and a list of all claims readable thereon, including any claims that may be subsequently added. Any traverse that a claim is allowable or that all claims are generic is considered an improper and incomplete response unless accompanied by an election.

Upon the allowance of a generic claim, the Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP§ 809.02 (a).

On the occasion Applicant traverses on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that

this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence may be used in a rejection under U.S.C. 103(a) of the other invention.

Election/Restrictions Proper

MPEP§ 809.02(d) states “[w]here only generic claims are presented, no restriction can be required except in those applications where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary.” In this instant, the claims recite such a multiplicity of species that an unduly extensive and burdensome search would be necessary if all of the claimed species were to be examined simultaneously.

The present claims are drawn to a practicing tissue paper product comprising a tissue paper substrate and a protease inhibiting composition. The classification of some of the active agents is co-extensive and that the compounds as claimed are patently distinct and fully capable of supporting separate patents.

For the above reasons, an election of a single disclosed species for examination purposes is deemed necessary and proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Inventorship Notice

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy E. Betton whose telephone number is (571) 272-9922. The examiner can normally be reached on Monday-Friday 8:30a - 5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TEB


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER